

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Paul J. Bruinsma

Confirmation No.: 6422

Serial No.: 09/481,988 Examiner: Paul Marcantoni

Filed: January 11, 2000 Group Art Unit: 1755

For: MESOPOROUS-SILICA FILMS, FIBERS, AND POWDERS BY  
EVAPORATION

Date: November 13, 2007

Mail Stop AMENDMENT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**COMMUNICATION**

Please find attached a communication with regard to the claims renumbering in this case.

### Remarks

Applicant's representative and Examiner Tierney discussed this issue in a phone call, but Applicant would like this communication entered into the file wrapper of this case.

This case been filed with the claims from the reissue patent application numbered as 1-27. During the course of prosecution, several more claims were added.

In an advisory action mailed on April 3, 2003, attached, the Examiner indicated that *all* of the claims, *including the original claims 1-27* be renumbered beginning with the number 129, as the added claims last number was claim 128.

When this case was allowed, it was allowed with 59 claims, numbered claims 129-187, of which claims 129-155 were the original claims 1-27 renumbered in accordance with the Examiner's direction.

In the IIFW document up on PAIR, the claims 1-27 are indicated as still being active, and the renumbering began with renumbering claims 129 as claim 28. However, claims 1-27 have not been active under those numbers since 2003. To renumber claims 129 as 28 and to continue to the final claim in the case, claim 187 would be claim 86, indicating that 86 claims were allowed.

Applicant objects to this renumbering and submits that the claims need to be renumbered differently, beginning with claim 1 being claim 129 and claim 59 being claim 187. Otherwise, if renumbered as indicated by the documents on PAIR, the case will issue with 86 claims, claims 1-27 and claims 28-55 being the exact same claims. Examiner Tierney did not believe that this could be achieved, so Applicant is making a record of his objection to this renumbering.

**Customer No. 20575**

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



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UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,988	01/11/2000	PAUL J. BRUINSMA	1941-70	6422

20575 7590 04/03/2003

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EXAMINER

MARCANTONI, PAUL D

ART UNIT	PAPER NUMBER
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1755

31

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

4/27/09

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/481,988	1/11/00	BRUNISMA et al.	1941-70

EXAMINER	
Paul Marcantoni	
ART UNIT	PAPER NUMBER
1755	31

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run 4 mos or continues to run \_\_\_\_\_ from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 3/27/03 and is not deemed to place the application in condition for allowance:

1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
  - c. ☐ They raise the issue of new matter. (See Note).
  - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: (See attached sheet)

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☐ Upon the filing an appeal, the proposed amendment ☐ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: 1-27, 40, 41, 58-60, 69-71, 78-82, 90-95, 98, + 109-115, + 128

Claims objected to: \_\_\_\_\_

Claims rejected: \_\_\_\_\_

However;

☒ Applicant's response has overcome the following rejection(s): claim 128 is allowable + case is in condition for allowance pending re-submission of amendments <sup>renumbering claims.</sup>

4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because \_\_\_\_\_

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

PAUL MARCANTONI  
PRIMARY EXAMINER  
68410 1100

Applicant's arguments filed 3/27/03 have been fully considered but they are persuasive. Claim 128 is determined to be allowable. Now claims 1-27,40,41,58-60,69-71,78-88,90-95,98,109-115, and 128 are in condition for allowance.

New Amendment:

It would be appreciated if applicants would submit the actual amendment faxed on 3/27 with only the the following request:

1) That applicants *cancel* all previous pending claims which are now allowable including claims 1,27,40,41,58-60,69-71,78-88,90-95,98,109-115, and 128.

And

2) Renumber those claims from the 3/27/03 amendment as newclaims starting with claim 129 onwards. The following sequence matches old claims and new claims to be submitted

Claim 1	should be renumbered	129
2	should be renumbered	130
3	" " "	131
4	" " "	132

etc.

128	should be renumbered	189
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This is being requested in order to expedite processing and prevent any delays at the printer due to the extensive case history and number of amendments during the 3

years of prosecution. Often cases with numerous amendments have the potential to cause problems and delay at the printer. Applicants' assistance in this matter is appreciated. A Notice of Allowability will be sent to applicants pending upon receipt of this amendment.

Applicants are respectfully requested to fax the same amendment as was faxed on 3/27/03 with the new claim numbers and cancellation of all previous claims.

The Tech Center 1700 Fax numbers are 703-872-9310 and 703-872-9311.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



Paul Marcantoni  
Primary Examiner  
Art Unit 1755